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Examiner: Lorna M. Douyam
Group Art Unit: 1751

REMARKS/ARGUMENTS

In the Office Action, restriction was required under 35 U.S.C. § 121 into four groups of claims:

1. Claims 1-48;
1. Claims 49-66;
2. Claims 67-86; and
4. Claims 87-93.

The restriction requirement is respectfully traversed.

35 U.S.C. § 121 reads in pertinent part as follows:

§ 121 Divisional Applications

If two are more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the two inventions. . . .

This language of the statute has been replicated in 37 C.F.R. § 1.141 (a):

§ 1.141 Different inventions in one national application.

- (a) Two or more independent and distinct inventions may not be claimed in one national application, except that more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form (§ 1.75) or otherwise include all the limitations of the generic claim.

Restriction is proper to one or more claimed inventions only if they are able to support separate patents and they are either independent or distinct. MPEP 803. The Examiner has the burden of demonstrating by reasons that a restriction requirement meets the statutory requirements. The Examiner must support his restriction requirement with reasons, not by a statement of conclusions. MPEP 808.

Every requirement for restriction has two aspects: (A) the reasons (as distinguished from mere statement of conclusion) why the inventions *as claimed*

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are either independent or distinct; and (B) the reasons for insisting upon restriction therebetween as set forth in the following sections. (Emphasis original).

MPEP 808.

The Examiner has not supported her restriction requirement because she has not demonstrated that the subject matter of the *claims* relating to each of the classes are able to support separate patents and that they are either independent or distinct. Further, the Examiner has failed to identify any reasons (as distinguished from mere statements of conclusion) as to why the inventions *as claimed* are either independent or distinct. The Examiner has not met her burden for requiring restriction.

Further, the Examiner has not met her burden for the restriction requirement because it has not been shown that there is a serious burden on the Examiner if the claims are not restricted.

CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The inventions must be independent or distinct as claimed [citations omitted]; and
- (B) There must be a serious burden on the Examiner if restriction is required [citations omitted].

MPEP 803.

With respect to the inventions of claims I, II, and III, all of them related to a spray cleaners which include an oxidizing composition. The fact that claims in the first two groups relate to an article of manufacture (not product) and the third class relates to a method, all of the claims relate to the dispensing of an oxidizing composition drawn to the surface to be cleaned. The claims in each of the three sets of claims call for aerosol propellant for dispensing an oxidizing composition with a propellant. Regardless of whether a prior art reference may be originally classified in a method subclass or an article subclass, the subject matter is the same and the field of

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search *must* include both areas. The Examiner cannot choose to avoid searching either of the two classes, regardless of whether she is searching an article or a method. The Examiner has not demonstrated that there is any burden on the Examiner for examining all of the claims in the four classes. The Examiner should be aware that Applicants have paid the filing fee for all of the claims and thus has paid the cost of examining all of these claims.

Contrary to the Examiner's representation, the process as claimed in claims 67-86 cannot be practiced with a carbonated cleaning solution. Both the claims require an oxidizing cleaning solution in their broadest aspects. The Examiner's statement is simply a conclusion and not a reason and is not supported by any evidentiary record.

The Examiner has also represented that claims I, II, and IV are unrelated because the inventions have different modes of operation and different effects. The Examiner has given no reasons to support her conclusion. The statement is merely a conclusion and not a reason. The Examiner has not met her burden with respect to the inventions of claims of the Examiner's groups I, II, and IV.

The Examiner has failed to support her representation that the inventions are distinct. No reasons have been given for the restriction requirement. Thus, the restriction requirement is improper and the examination must take place on all sets of claims.

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Applicants provisionally elects the subject matter of claims 49-66, the Examiner's group II, for prosecution in this application, should the Examiner make the restriction requirement final.

Respectfully submitted,

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